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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,209	09/27/2000	Birgit Boge	HER07 P-106	5284

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EXAMINER

WACHTEL, ALEXIS A

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 03/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,209

Applicant(s)

BOGE ET AL.

Examiner

Alexis Wachtel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 8-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Detailed Action

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2 and 8-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,866,905 to Bihiy et al.

The limitations relating to the specifically claimed graphically marked designs on the surface of the claimed mineral wool sheet are given no patentable weight as they do not structurally affect the final product. Examiner does give weight to the fact that Applicant's claimed article has either functional or decorative indicia located thereon. Appropriately applied prior art must have either decorative or functional indicia means located on the Applicant's claimed article.

Bihiy et al discloses a mineral fiber material available in roll form (Col 2, lines 44-46) which meets the "insulation material sheet" limitations of claims 1,2 and 26. To facilitate guidance of the cut for separating the portions of the mineral fiber strip, markings can be provided on one side of said mineral fiber strip (Abstract).

Bihiy et al as set forth teaches the claimed invention except for the specific graphic design. Since Bihiy et al as set forth above teaches to provide functional graphics on the mineral fiber material, it would have been a matter of obvious design

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choice to have provided any specific functional design motivated by the desire to provide a user improved instructions or improved product aesthetics.

3. Claims 1,2 and 8-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3713108A.

The limitations relating to the specifically claimed graphically marked designs on the surface of the claimed mineral wool sheet are given no patentable weight as they do not structurally affect the final product. Examiner does give weight to the fact that Applicant's claimed article has either functional or decorative indicia located thereon. Appropriately applied prior art must have either decorative or functional indicia means located on the Applicant's claimed article.

DE 3713108A discloses a mineral fiber web (English Abstract) which meets the "insulation material sheet" limitations of claims 1 and 2. In addition a method is disclosed for applying marking lines to a mineral fiber web for guiding cuts made to said mineral fiber web (English Abstract).

DE 3713108A as set forth teaches the claimed invention except for the specific graphic design. Since DE 3713108A as set forth above teaches to provide functional graphics on the mineral fiber material, it would have been a matter of obvious design choice to have provided any specific functional design motivated by the desire to provide a user improved instructions or improved product aesthetics.

4. Claims 1,2 and 8-35 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 795424 A1.

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The limitations relating to the specifically claimed graphically marked designs on the surface of the claimed mineral wool sheet are given no patentable weight as they do not structurally affect the final product. Examiner does give weight to the fact that Applicant's claimed article has either functional or decorative indicia located thereon. Appropriately applied prior art must have either decorative or functional indicia means located on the Applicant's claimed article.

EP 795424 A1 discloses as known, boards made of mineral fibers (English Abstract) which meets the "insulation material sheet" limitations of claims 1 and 2. In addition, EP 795424 A1 discloses applying markings to a mineral fiber material for guiding cuts made said mineral fiber material (English Abstract).

EP 795424 A1 as set forth above teaches the claimed invention except for the specific graphic design. Since EP 795424 A1 as set forth above teaches to provide functional graphics on the mineral fiber material, it would have been a matter of obvious design choice to have provided any specific functional design motivated by the desire to provide a user improved instructions or improved product aesthetics.

Examiner Comments

5. Applicant misinterprets *In re Miller*, 164 USPW 46 (CCPA 1969). The court stated as follows:

As for the examiner's characterization of the indicia and legend as "unpatentable printed matter," we note that the examiner himself recognized the fact that printed matter can be given "patentable weight." He did so in allowing claims. His characterization of printed matter as "unpatentable" is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no

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reason for ignoring it when the claim is directed to the combination. Here is a new and unobvious functional relationship between a measuring reseptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio, and in our judgement the appeal claims properly define this relationship.

Interpreted correctly, *In re Miller* implicitly sets forth the following requirements to be met by the examiner when making rejections of printed articles:

1. Prior art combination must yield Applicant's article structure
2. Prior art taken alone or in combination with other prior art must disclose indicia on said article.
3. Indicia must conceptually serve the same purpose as Applicant claims be it decorative or functional.

Example: In Applicant's instantaneously claimed invention, a prior art mineral wool fiber mat having decorative designs would fail to meet the requirements set forth in *In re Miller* if Applicant's indicia serves as instructional indicia.

Examiner has not summarily dismissed the requirement of Applicant's article to have functional indicia thereon. Examiner has given weight to the fact that functional indicia is present. The relied upon prior art clearly describes and illustrates a known and obvious functional relationship between mineral wool mats and instructive/functional indicia. *In re Miller*, however, describes the situation whereby the examiner summarily dismissed the presence of indicia as well as its functionality. To be sure, Examiner concedes that references lacking functional indicia means having a similar conceptual purpose as claimed by Applicant would in fact not meet the requirements set forth by *In re Miller*.

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In re Miller recognizes that the measuring receptacle had novel and conceptually unobvious indicia means located thereon. In the instantaneous application, this is clearly not the case. Applicant claims that the concept of providing functional indicia on mineral wool mats renders Applicant's indicia design choice arguments moot in view of the cited case law. However, as set forth above, Applicant has failed to show that the concept of applying such indicia means for the stated purpose is unobvious over the disclosures of the relied upon prior art.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alex Wachtel, whose number is (703)-306-0320. The Examiner can normally be reached Mondays-Fridays from 10:30am to 6:30pm.

If attempts to reach the Examiner by telephone are unsuccessful and the matter is urgent, the Examiner's supervisor, Mr. Glenn Caldarola can be reached at (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



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